

EXHIBIT C

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

OVERTURE SERVICES, INC., a)
Delaware corporation,)
Plaintiff,)
vs.) No. C02-01991 CRB
GOOGLE INC., a California)
corporation,)
Defendant.)

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DEPOSITION OF ELAINE K. LEE

San Francisco, California

Friday, July 18, 2003

Reported by:
RACHEL FERRIER

CSR No. 6948

Job No. 44447

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1 graduate studies at Davis?

09:17 2 A I was a systems engineering intern at Sun
3 Microsystems from about May 1998 through August 1998.

09:17 4 Q Was that a summer position?

09:17 5 A It was kind of -- it was not really a summer
6 position, but it was an intern -- classified as an
7 intern position, so --

09:17 8 Q That's a temporary position --

09:18 9 A Temporary, right. You are an employee of Sun
10 Microsystems, but you are not a full-time employee.

09:18 11 Q What did you do after ending that internship?

09:18 12 A I took a job as an associate attorney at Brinks
13 Hofer Gilson & Lione in Chicago.

09:18 14 Q When did you start work there?

09:18 15 A About probably September of 1998.

09:18 16 Q When did you leave Brinks?

09:18 17 A January of 2000.

09:18 18 Q When you started working at Brinks, were you
19 assigned to any particular group or practice area?

09:18 20 A I was in the I guess patent -- patent area.
21 You know, I focused on patents and also I focused on I
22 guess the electrical computer area. But I wasn't -- I
23 think if there was an assignment, I think that was it.

09:18 24 Q Okay.

09:18 25 A Okay?

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09:43 1 Q Sure.

09:43 2 Is there anything that you can remember about

3 any of the work that any of them had done that led you

4 to conclude they should be listed as inventors, any of

5 them?

09:44 6 A I don't recall. I can only -- I don't recall

7 what specific contributions each inventor made.

09:44 8 Q Okay. Have you ever become aware that any

9 errors were made in terms of identifying the inventors

10 of what issued as the '361 patent?

09:44 11 A No. During my prosecution of this, I was not

12 aware of any inventor errors.

09:44 13 Q Have you subsequently become aware of any

14 inventor errors?

09:44 15 A I believe an inventor may have been added, but

16 I -- I don't know the substance of that.

09:44 17 Q Okay. Do you have any understanding as to why

18 inventors may have been added?

09:45 19 A No.

09:45 20 Q Do you know who those purported inventors are?

09:45 21 A I recall that one was named -- one was Tom

22 Soulanille.

09:45 23 Q You had spoken with Tom Soulanille in -- strike

24 that.

09:45 25 You had spoken with Tom Soulanille in

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1 conjunction with drafting the original patent
2 application; is that right?

09:45 3 A Right.

09:45 4 Q Do you have any recollection of what it was
5 that you and Mr. Soulanille had discussed?

09:45 6 A It was basically a very high-level technical
7 discussion of what GoTo was -- you know, about GoTo's
8 engineering efforts.

09:45 9 Q Okay. Do you remember any specific technical
10 feature that you discussed with him?

09:45 11 A We didn't discuss any inventions, any -- you
12 know, any specific technical features in detail. It was
13 a very high-level discussion.

09:46 14 Q Do you recall whether you spoke to
15 Mr. Soulanille once or more than once?

09:46 16 A At least once.

09:46 17 Q Did you consider the question, in connection
18 with drafting the patent application, whether
19 Mr. Soulanille should be listed as an inventor?

09:46 20 A Yes, I believe I did.

09:46 21 Q What conclusion did you reach?

09:46 22 A I believe that he -- as the claims as I had
23 drafted -- I don't -- I don't recall, but I just recall
24 discussing it with him.

09:46 25 Q Okay. Well, does the fact that he wasn't

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1 listed as one of the inventors in the original patent
2 application lead you to believe that you had reached the
3 conclusion that he should not be so listed?

09:46 4 A I can't really answer that. I mean, I think --
5 I do recall speaking with him, and I recall going
6 through the analysis with him and discussing it also
7 with several individuals involved in the patent
8 prosecution.

09:47 9 Q But can you remember anything -- you said you
10 remember going through the analysis with Mr. Soulanille
11 as to whether he was someone who would be an inventor;
12 is that right?

09:47 13 A I don't recall going through the analysis
14 necessarily with him or -- but, we --

09:47 15 Q Let me back up.

09:47 16 Do you remember considering the question
17 whether Mr. Soulanille should be listed as an inventor?

09:47 18 A I don't recall exactly, but I do recall that I
19 discussed technical aspects with him.

09:47 20 Q Okay. Well, would it be your normal practice
21 to -- if you spoke with an individual at a company who
22 was involved in some way with an invention, to evaluate
23 whether they were someone who ought to be listed as an
24 inventor?

09:47 25 A Sure.

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1 specific website, but it was publicly available.

09:58 2 Q Okay. And to the extent that the -- that the
3 GoTo system had been available on GoTo's website, would
4 that fall within the penumbra of what you are defining
5 as publicly available?

09:58 6 A Yes.

09:58 7 Q Is there anything more specific that you can
8 recall about the information that you learned about when
9 it was that GoTo had a prior version of the GoTo system
10 available on the GoTo website or otherwise publicly
11 available?

09:59 12 A No.

09:59 13 Q Did you conduct any investigation into the
14 features of the system that were included within what
15 you have defined as this first release?

09:59 16 A I don't know if it was the first release.

09:59 17 Q Okay.

09:59 18 A I'm just saying --

09:59 19 Q Fair enough. In that case --

09:59 20 A Okay.

09:59 21 Q -- do you recall conducting any investigation
22 into the features of the system that had previously been
23 made available on the GoTo website or otherwise made
24 publicly available?

09:59 25 A Yes.

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09:59 1 Q Okay. What do you recall learning as a result
2 of that investigation?

09:59 3 A That there -- you know, I just learned about
4 certain features that had been -- that were made
5 publicly available and that they had -- they were
6 working on a newer version that had some additional
7 features.

10:00 8 Q Okay. Can you remember any of the specific
9 features that had been made publicly available
10 previously?

10:00 11 A No.

10:00 12 Q Do you remember having conversations with
13 anyone about whether it would be desirable to seek
14 patent protection for any of those features?

10:00 15 A Any of what features?

10:00 16 Q The features that had previously been publicly
17 available.

10:00 18 A Prior to my speaking with them?

10:00 19 Q Right.

10:00 20 A I do recall discussing with them what can and
21 cannot be patented related to those features.

10:00 22 Q Okay.

10:00 23 A You know, and what jurisdictions.

10:00 24 MS. DURIE: And I take it, Jason, that if I ask --
25 well, let me just make a record.

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1 made publicly available?

10:09 2 MR. WHITE: I'm going to object to that as being
3 vague with respect to "the GoTo system."

10:09 4 BY MS. DURIE:

10:09 5 Q "The GoTo system" as we have defined it,
6 pay-for-placement system for advertising.

10:10 7 MR. WHITE: Same objection.

10:10 8 THE WITNESS: That was publicly available?

10:10 9 BY MS. DURIE:

10:10 10 Q That was publicly available, whatever it was.

10:10 11 A Okay. I recall that at the time of filing I
12 believed that those claims encompassed new material that
13 was not part of the GoTo system as we have defined it.

10:10 14 Q Why is it that you remember that?

10:10 15 A Because I do recall discussing this at length
16 with various of the inventors.

10:10 17 Q Was there any reason that you drafted the
18 claims in such a way that they included features that
19 you believed were not present in the original GoTo
20 system that had been publicly released?

10:11 21 A Yes. One reason would be to make this
22 application eligible for foreign filing.

10:11 23 Q Can you explain that to me.

10:11 24 A If you file -- if you establish a priority date
25 by filing in the U.S. Patent Office before the first

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1 contained within this IDS?

10:36 2 A I believe a lot of the information came
3 directly from GoTo employees.

10:36 4 Q Okay. Do you remember conducting or
5 instructing that a search be conducted for relevant
6 prior art?

10:36 7 A Can you specify what you mean by "search."

10:37 8 Q Well, any attempt to uncover relevant prior
9 art.

10:37 10 A Relevant --

10:37 11 Q Prior art.

10:37 12 A I believe we asked --

10:37 13 MR. WHITE: Be careful not to reveal any
14 attorney-client communications that you may have had.

10:37 15 THE WITNESS: Right.

10:37 16 MR. WHITE: You can answer "Yes" or "No."

10:37 17 THE WITNESS: Okay. Yes.

10:37 18 BY MS. DURIE:

10:37 19 Q Okay. Was that search conducted in part by
20 individuals at GoTo?

10:37 21 A They provided -- they provided information to
22 me. I don't know what activities they did to get that
23 information.

10:37 24 Q Did you independently conduct any search for
25 potentially relevant prior art?

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10:37 1 A I may have conducted a search or asked that a
2 search be conducted, but I don't recall exactly.

10:37 3 Q You don't remember one way or the other?

10:38 4 A I don't remember one way or the other.

10:38 5 Q Okay. Do you have any knowledge as to whether
6 anyone else at Brinks conducted such a search?

10:40 7 A No.

10:40 8 Q Okay. Let me show you what's previously been
9 marked as Exhibit 10.

10:40 10 A Mm-hmm.

10:40 11 Q Have you had a chance to look at Exhibit 10?

10:40 12 A Yeah.

10:40 13 Q Have you seen it before?

10:40 14 A I don't recall exactly.

10:40 15 Q Do you have any recollection as to whether you
16 had ever seen Exhibit 10 as of the date that the IDS was
17 submitted?

10:41 18 A I don't recall. To the extent -- I mean, I do
19 recall looking at press releases.

10:41 20 Q Okay. Do you have any understanding -- I will
21 represent to you that Exhibit 10 is not listed on the
22 IDS.

10:41 23 A Okay.

10:41 24 Q Do you have any understanding as to why that
25 would be?

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10:41 1 A No.

10:41 2 Q Do you know whether GoTo provided a copy of

3 Exhibit 10 to Brinks Hofer prior to the submission of

4 the IDS?

10:41 5 A Do I know whether they provided a copy of this

6 to us?

10:41 7 Q Yeah.

10:41 8 A No, I don't know. My general practice was, I

9 think I asked for press releases and they provided me

10 with -- whatever they provided me with I filed as -- I

11 included in the information disclosure statement.

10:41 12 So my -- you know, if I didn't receive it, I

13 obviously can't file what I didn't receive.

10:42 14 Q Okay. But you don't know one way or the other

15 whether you did receive it; is that right?

10:42 16 A Right.

10:42 17 Q And I take it you also don't know one way or

18 the other whether you conducted any independent search

19 for press releases?

10:42 20 A I worked with GoTo employees and they provided

21 me with press releases, yeah.

10:42 22 Q So is it therefore fair to say that you did not

23 conduct any independent search for press releases apart

24 from relying on the information that was provided to you

25 by GoTo employees?

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10:42 1 A Apart from GoTo and what was on the website.

10:42 2 Q Okay. I would like you to -- I see that you

3 still have Exhibit 3 in front of you. If you could have

4 Claim 1 in front of you.

10:43 5 A Right.

10:43 6 Q And I would like to talk to you a little bit

7 about Claim 1 and this press release that is Exhibit 10.

10:44 8 A Mm-hmm.

10:44 9 Q If you could turn to -- if you could take a

10 look at the -- at Claim 1, the first element after the

11 "Comprising," "Maintaining a database including a

12 plurality of search listings wherein each search listing

13 is associated with a bid amount and a search term."

10:44 14 A Right.

10:44 15 Q You had previously indicated that you weren't

16 sure whether or not that element was met by the system

17 that had been in prior public use.

10:44 18 A Right.

10:44 19 Q You see that the date of this press release is

20 May 19th, 1998?

10:44 21 A Mm-hmm.

10:44 22 Q And the application was filed on May 28th,

23 1999, the patent application?

10:44 24 A Okay.

10:44 25 Q And I'll represent that to you, and you can see

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1 the -- a year prior to the filing date of the
2 application or before?

11:35 3 A No.

11:35 4 Q Did you draft paragraph 10?

11:36 5 A Yes.

11:36 6 Q Paragraph 10 does not state that it's being
7 offered on information and belief; correct?

11:36 8 A I would have to -- I don't know.

11:36 9 Q Feel free to read it.

11:36 10 A Okay. Well, the phrase, "On information and
11 belief" doesn't appear.

11:36 12 Q Did you do anything to ascertain whether
13 Mr. Davis had personal knowledge of the matters to which
14 he was attesting in paragraph 10?

11:36 15 A I don't recall. I would -- you know, my normal
16 practice would be to make sure that everything that he's
17 attesting to is truthful, so I would assume that I would
18 have made -- I would have made that -- made certain of
19 that.

11:37 20 Q Would it be your normal practice to ask an
21 individual who is submitting a declaration whether they
22 had personal knowledge of the statements that they were
23 making?

11:37 24 A These statements say whether he knows or
25 believes something and -- I mean, whether or not

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1 something happened. I mean, I think that's -- I think
2 everything that he said -- I mean, I've -- I asked him
3 if he's -- if he can attest to the truthfulness of those
4 and he said, you know, he did.

11:37 5 MR. WHITE: Careful not to reveal any specific
6 communication.

11:37 7 THE WITNESS: Sure.

11:37 8 BY MS. DURIE:

11:37 9 Q Let me ask you again.

11:37 10 Would it be your normal practice to ascertain
11 whether a declarant had personal knowledge of the truth
12 of the statements that he was making in the declaration?

11:37 13 A I would ask him to ascertain that the
14 statements he's making are truthful.

11:38 15 Q Okay. Would you -- would it be your practice
16 to ask a declarant whether he had personal knowledge of
17 the matters to which he was attesting in order to make a
18 determination as to whether those matters should be
19 stated on information and belief?

11:38 20 A If he has personal knowledge that -- you know,
21 that information -- statements he was making on
22 information and -- you know, it's just if he has --
23 whatever he has personal knowledge to, he should -- you
24 know, he can attest to.

11:38 25 Q Okay. And so --

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11:38 1 A Everything -- all the statements that he should
2 make are truthful.

11:38 3 Q Okay. But you would then, I take it, try to
4 find out what things he could say based on his own --
5 truthfully say based on his own personal knowledge and
6 what things he could truthfully say based on information
7 and belief, as your general practice?

11:39 8 A Sure, to the -- yeah.

11:39 9 Q Okay. Do you have any reason to believe that
10 you deviated from that general practice here?

11:39 11 A No.

11:39 12 Q Do you remember having discussions with anyone
13 else at GoTo.com about whether they would be competent
14 to submit a declaration in support of a petition to make
15 special?

11:39 16 MR. WHITE: Just a "Yes" or "No" answer to that
17 question right now.

11:39 18 THE WITNESS: Could you repeat the question.

11:39 19 BY MS. DURIE:

11:39 20 Q Sure.

11:39 21 Do you recall having discussions with anyone
22 else at GoTo about whether they would be competent to
23 submit a declaration in support of the petition to make
24 special?

11:39 25 A Yes.

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11:42 1 A Right, if they had that knowledge based on
2 information and belief.

11:42 3 Q Okay. So if Mr. Davis had told you that he
4 didn't have personal knowledge of the features of the
5 GoTo system more than a year prior to the filing date,
6 based on your practice, do you believe that you would
7 have drafted Exhibit 10 -- I mean, paragraph 10 of his
8 declaration to reflect that the statements were being
9 made on information and belief?

11:42 10 MR. WHITE: Objection; calls for speculation.

11:42 11 THE WITNESS: Can you ask the question again.

11:42 12 BY MS. DURIE:

11:42 13 Q Sure.

11:42 14 MS. DURIE: Can you read it back.

11:42 15 (Record read by Reporter as follows:

11:42 16 "Question: So if Mr. Davis had told you that
17 he didn't have personal knowledge of the
18 features of the GoTo system more than a year
19 prior to the filing date, based on your
20 practice, do you believe that you would have
21 drafted . . . paragraph 10 of his declaration
22 to reflect that the statements were being made
23 on information and belief?"

11:43 24 MR. WHITE: Same objection.

11:43 25 THE WITNESS: I may have drafted statement 10

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1 differently. Whether I would have said it's on
2 information and belief, I don't know.

11:43 3 BY MS. DURIE:

11:43 4 Q Okay. In Mr. Davis's declaration, he states
5 that he's made a rigid comparison of the claims of the
6 patent application and the potentially infringing
7 systems.

11:43 8 A Mm-hmm.

11:43 9 Q What is a rigid comparison?

11:43 10 A I guess my understanding would be that you look
11 at the claim elements and you also compare it -- you
12 compare it to the system -- the system.

11:44 13 Q Was it your understanding that any of the
14 claims in the patent application as it then -- as it
15 existed as of the date of the petition to make special
16 were limited to a system that charged advertisers on a
17 cost-per-click basis?

11:44 18 A I'm sorry, can you repeat the question.

11:44 19 Q Sure.

11:44 20 Was it your understanding at the time you
21 submitted the petition to make special that any of the
22 claims of the patent application, as it then existed,
23 were limited to a system that charged advertisers on a
24 cost-per-click basis?

11:45 25 MR. WHITE: Objection; calls for a legal

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5 I, the undersigned, a Certified Shorthand

Reporter of the State of California, do hereby certify:

6

7 That the foregoing proceedings were taken
before me at the time and place herein set forth; that
8 any witnesses in the foregoing proceedings, prior to
9 testifying, were placed under oath; that a verbatim
10 record of the proceedings was made by me using machine
11 shorthand which was thereafter transcribed under my
12 direction; further, that the foregoing is an accurate
13 transcription thereof.

14

15 I further certify that I am neither
16 financially interested in the action nor a relative or
employee of any attorney of any of the parties.

17

18 IN WITNESS HEREOF, I have this date
subscribed my name.

19

20

AUG 05 2003

Dated: _____

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